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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.	205
09/377,827	08/20/99	SUGI YAMA		A	1453-1001/JD
			EXAMINER		
ATTN JAMES D HALSEY JR STAAS & HALSEY 700 ELEVENTH STREET NW SUITE 500 WASHINGTON DC 20001			MMC2/0810	FLETCHER, M	
			ART UNIT	PAPER NUMBER	
				2837	
			DATE MAILED:	05/10/00	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/377,827</b>	Applicant(s) <b>Sugiyama</b>
	Examiner <b>Marlon Fletcher</b>	Group Art Unit <b>2837</b>

Responsive to communication(s) filed on Aug 20, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-5 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-5 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Drawings***

1. New formal drawings are required in this application because the drawings are written in Japanese. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

As stated in 37 CFR 1.84, "the English alphabet must be used for letters, except where another alphabet is customarily used, such as the Greek alphabet to indicate angles, wavelengths, and mathematical formulas."

2. The drawings are objected to because the figures in the drawing must be labeled. For example, figure 1 should be labeled as Figure 1. The figures should not just be labeled by a number as seen in the submitted drawings. Correction is required.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

On page 6, lines 24-25, reference is made to a "branch path 9." There is no "branch path 9" shown in the drawings. Correction is required.

### ***Specification***

4. Applicant is reminded of the proper content of an abstract of the disclosure.

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A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because the abstract refers to purported merits of the invention. The abstract is a repetition of the claim language. The abstract further

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contains the legal phraseology "said" as seen in lines seen in lines 2, 4, and 5, which is not permitted. The abstract further provides a first sentence which is a run-on sentence and is incomprehensible. The second sentence is not clear as well. A new abstract is required. Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities:

On page 1, line 3, under the "Background of the Invention", after the word "using" the word "a" should be inserted.

On page 1, line 5, under the "2, Description of the Prior Art", the back slash " / " should be deleted.

On page 3, lines 10-11, the phrase "result of process produced by computer .... basically" provides improper sentence structure. For example, the phrase could be properly written, "a result of a process produced by a computer is made from input data input from a keyboard."

On page 3, lines 11-14, the sentence "In the first processing method ..... has previously been made", lacks proper sentence structure.

On page 3, line 19, the word "form" is misspelled and should be "from."

On page 3, line 20, the phrase "for another codes" contains improper word agreement.

The word "another" is in singular form and the word "codes" is in plural form.

On page 3, line 22, the phrase "staff code are" contains improper subject-verb agreement.

The word "code" is in singular form and the word "are" is in plural form.

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On page 3, line 24, the word “finally,” should be deleted and the word “and” should be inserted.

On page 3, lines 26-28, the phrase “as the same method of the first it, scale ..... has previously been made” contains improper sentence structure.

On page 4, lines 3-4, the sentence “And various programs, tables are .... ” lack proper sentence structure.

On page 4, lines 10-11, the sentence “The data are able to store ... or are able to output form the computer” does not make sense and lacks improper sentence structure. The sentence can be corrected as “The data are stored in the music staff code memory, or the data are output from the computer.”

On page 4, lines 11-14, the sentence “The enumerated musical staff code are ..... and illustration” contain improper subject-verb agreement and lack proper sentence structure.

On page 10, lines 22-26, the sentence “In the invention according to claims 2 ..... between both sites” should be deleted in its entirety. The specification should not refer to the claims. The claims refer to the specification.

The specification contains so many minor errors that they could not all be pointed out. The applicant must review the entire disclosure for such errors and make the proper corrections.

Appropriate correction is required.

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***Claim Objections***

8. Claims 1-5 are objected to because of the following informalities:

In claim 1, line 1, after the word “using” the word “a” should be inserted.

In claim 1, line 2, the word “to” should be change to “into”.

In claim 1, line 7, after the word “order;” the conjunction “and” should be inserted.

In claim 1, line 8, the word “output” should be changed to “outputting.”

In claim 2, line 1, after the word “using” the word “a” should be inserted.

In claim 3, line 1, after the word “using” the word “a” should be inserted.

In claim 3, line 2, the word “decode” should be changed to “decoder.”

In claim 4, line 1, after the word “using” the word “a” should be inserted.

In claim 4, line 2, the word “decode” should be changed to “decoder.”

In claim 5, line 1, after the word “using” the word “a” should be inserted.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claims 1-5 are rejected under 35 U.S.C., 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, the phrase “a listing of note code table” is indefinite. It appears that the applicant is claiming “a listing of note codes in a table.”

In claim 1, line 4, the phrase “decoding from input data to corresponded scale code” is indefinite. It is not clear as to what the applicant is claiming. It appears that the claim is reciting a limitation wherein a note decoder decodes the input data to correspond to scales of music staff notation by using the listing of note codes in the table. Correction is required.

In claim 1, line 7, the phrase “with in order” is indefinite. It is not clear as to what the applicant is claiming. Is the “order” referring to the order in which the notes are decoded? The claim should be written in a clear and definite manner.

In claim 2, line 2, the phrase “listing of note code table” is indefinite. It appears that the applicant is claiming “a listing of note codes in a table.”

In claim 2, line 3, the phrase “arranged in order” is indefinite. How is the data arranged in order? The data will inherently be in some type of order.

In claim 2, line 4, the phrase “arranged in random the scale” is indefinite. The claim does not clearly point out what applicant regards as the claim limitation.

In claim 3, line 2, the phrase “listing of note code table” is indefinite.

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In claim 3, lines 2-3, the phrase “note code table in the note decoder are plural list” is indefinite. Are there plural lists in the table? The recitation is not clear.

In claim 3, line 3, the phrase “arranged in random” is indefinite.

In claim 4, line 2, the phrase “listing of note code table” is indefinite.

In claim 4, line 3, the phrase “arranged in random” is indefinite.

In claim 4, line 4, the phrase “arranged in random” is indefinite.

In claim 5, line 2, the phrase “plural listing of note code table” is indefinite.

In claim 5, lines 2-3, the phrase “are selectable listing” is indefinite. What is meant by selectable listing?

11. Claim 1 recites the limitation "corresponded scale code data" in lines 4-5. There is insufficient antecedent basis for this limitation in the claim.

There is no previous recitation of “scale code data.”

12. Claim 1 recites the limitation "memorizing output data" in line 6. There is insufficient antecedent basis for this limitation in the claim.

There is no previous recitation of the note decoder providing output data.

13. Claim 1 recites the limitation "the music staff notation data" in line 8. There is insufficient antecedent basis for this limitation in the claim.

There is no prior recitation of music staff notation data. There is only the prior recitations of “staff notation” and “scales of music staff notation.”

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14. Claim 2 recites the limitation "said listing of note code table in the note decoder" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

There is no prior recitation of "said listing of note code table" being in the note decoder.

At most, as previously recited, the table is used by the note decoder to decodes notes from the input data.

15. Claim 3 recites the limitation "said listing of note code table in the note decoder" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

16. Claim 4 recites the limitation "said listing of note code table in the note decoder" in line 2.

There is insufficient antecedent basis for this limitation in the claim.

17. Claim 5 recites the limitation "said plural listing of note code table" in line 2. There is insufficient antecedent basis for this limitation in the claim.

There is no previous recitation in claim 1 of "plural listing of note code table."

18. Claim 5 recites the limitation "said plural listing of note code table in the note decoder" in line 2. There is insufficient antecedent basis for this limitation in the claim.

There is no prior recitation of "said listing of note code table" being in the note decoder.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh et al. (5,038,659) in view of Tanimoto (4,450,743).

Satoh et al. disclose a musical score apparatus including a data processor (3) using a computer and a staff notation comprising: tables corresponding with data input to the computer and scales of music staff notation as discussed in column 5, line 67 through column 6, line 2, and column 9, lines 8-25, and as can be seen in figures 17-19; a note decoder for decoding the input data to correspond to scales or notes of a scale as discussed in column 3, lines 46-61; column 6, lines 7-9 and lines 20-23; and column 8, lines 52-57; a note code storage device (7) memorizing an output from the note decoder as discussed in column 5, lines 4-7; and an output means (4) for outputting music staff notation data from the note code storage device as discussed in column 5, lines 8-14.

Satoh et al. do not disclose table providing a listing of note codes that correspond to the input data.

However, Tanimoto discloses note code tables that correspond to the input data as seen in and discussed in columns 5 and 6, which correspond to figures 1-4, wherein input data and note codes also correspond to musical staff notation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Tanimoto with the apparatus of Satoh et al., because Tanimoto

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provides a clear correlation of input data with stored table data including note codes to produce output data, wherein Satoh et al. provide correlation of input data with output data, only failing to show a clear correlation with note codes.

21. Based on the rejection of claims 2-5 under 35 USC 112, second paragraph, claims 2-5 are so indefinite that it can not be distinguished to what the applicant is claiming, and therefore art is not applied to claims 2-5.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davis et al. (3,926,088) is recited as pertinent art, because the reference discloses a data processing apparatus that converts or decodes an input signal produced from a keyboard, using a computer to generate musical notation output on a display device.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marlon Fletcher whose telephone number is (703) 308-0848.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Nappi, can be reached on (703) 308-3370. The fax phone number for the organization where this application or proceeding is assigned is (703) 307-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MTF  
  
May 7, 2000

Marlon Fletcher

Patent Examiner

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